

REMARKS

In the Office Action mailed June 25, 2007 from the United States Patent and Trademark Office, the Examiner rejected claims 16-20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, rejected claims 1-4, 11-13, 15-17, and 20-22 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,139,097 to Wu et al. (hereinafter "Wu"), and rejected claims 6-10, 14, and 19 as being unpatentable over Wu and further in view of U.S. Patent Application Publication No. 2003/0081274 to Yamamoto (hereinafter "Yamamoto"). The Examiner also indicated that claims 5 and 18 contained allowable subject matter. Applicant respectfully provides the following:

New Claims 23 and 24:

Applicant has added new claims 23 and 24 to the application. New claims 23 and 24 correspond to original claims 5 and 18 rewritten in independent form including all of the limitations of the original base claims and all original intervening claims. Please note that claim 24 has also been changed slightly from the original to comply with the Examiner's suggested format regarding 35 U.S.C. § 101. Applicant respectfully submits that claims 23 and 24 are therefore allowable.

Rejections under 35 U.S.C. § 101:

In the Office Action, the Examiner rejected claims 16-20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant has amended the claims to conform with the format suggested by the Examiner and respectfully submits that the rejections have been overcome.

Rejections under 35 U.S.C. § 102(e):

In the Office Action, the Examiner rejected claims 1-4, 11-13, 15-17, and 20-22 under 35 U.S.C. § 102(e) as being anticipated by Wu. M.P.E.P. § 2131 sets forth the standard for a rejection of a claim as anticipated under 35 U.S.C. § 102. "To anticipate a claim, the reference must teach every element of the claim." M.P.E.P. § 2131 states further,

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . . . "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant respectfully submits that the reference cited by the Examiner fails to teach every element of the claim set as provided herein for the following reasons.

Independent claim 1, as amended, requires:

A method for dynamically generating a printer model database through print job analysis, the method comprising:

using a printer model database generation application to dynamically generate a plurality of test print jobs for delivery to a first printer driver;

using a printer model database generation post-spooling process to capture the test print jobs as output by the first printer driver;

exchanging test sequence information between the printer model database generation application and the printer model database generation post-spooling process, wherein the test sequence information is associated with the plurality of test print jobs;

archiving the test print jobs; and

using the printer model database generation application to perform an analysis process comparing differences between the plurality of test print jobs as output by the first printer driver to generate a printer model database entry for the first printer driver.

Such limitations are not taught, expressly or inherently, in Wu. Specifically, Wu teaches a system and method for testing the output of a digital imaging system by comparing the output of

a test job sent to the digital imaging system with control information produced by sending an identical test job to a control digital imaging system. (Abstract, Col 1 lines 62-64, Col 2 lines 34-37, Col 10 lines 57-60) The test between the digital imaging system being tested and the control digital imaging system of Wu is to verify the quality of new device drivers. (See Col 1 lines 37-40, for example.)

Because Wu only teaches the comparison of output of the same print test job from different device drivers, Wu cannot be said to teach the claim limitations of: “generating a plurality of test print jobs for delivery to a first printer driver,” “using a printer model database generation post-spooling process to capture the test print jobs as output by the first printer driver,” and “using the printer model database generation application to perform an analysis process comparing differences between the plurality of test print jobs as output by the first printer driver to generate a printer model database entry for the first printer driver.” Therefore, claim 1, as amended, is not anticipated by Wu.

Claim 12, as amended, requires: “a printer model database generation application configured to dynamically generate a plurality of test print jobs, to send the plurality of test print jobs to a first printer driver, and to perform an analysis process to generate a printer model database entry based on differences between the plurality of generated test print jobs sent to the first printer driver,” and “a printer model database generation post-spooling process configured to capture the plurality of test print jobs as output by the first printer driver.” As claim 12 requires that the printer model database generation application is configured to perform an analysis process to generate a printer model database entry based on differences between the plurality of generated test print jobs sent to the first printer driver, it is clear that claim 12 is

distinguished from and not anticipated by Wu's comparison of a single test case from multiple printer drivers.

Claim 21, as amended, requires:

- generating a base sequence test print job;
- capturing output information for the base sequence test print job from a first printer driver;
- generating a command specific print job wherein one option is configured differently than in the base sequence test print job;
- capturing driver output for the command specific print job from the first printer driver; and
- comparing the driver output for the command specific print job and the output information for the base sequence test print job to determine the imaging device command for communicating the one option.

Because claim 21 requires comparing the driver output for the command specific print job and the output information for the base sequence test print job, both being explicitly recited as being captured from the first printer driver, Wu does not anticipate claim 21. Instead, Wu requires comparing output from at least two printer drivers (see above discussion), which is an entirely different system than that claimed by Applicant.

Claim 16, as amended, contains similar limitations to those contained in claim 1 as discussed above. Claim 16 is therefore not anticipated by Wu. Regarding claim 22, claim 22 contains similar limitations to those discussed above with respect to claim 21. Therefore claim 21 is not anticipated by Wu. Claims 2-4, 11, 13, 15, 17, and 20 depend from one of claims 1, 12, or 16, which Applicant has shown are not anticipated by Wu. These dependent claims are therefore allowable by dependency on an allowable claim.

For at least these reasons, Applicant respectfully requests removal of all rejections under 35 U.S.C. § 102(e).

Rejections under 35 U.S.C. § 103(a):

In the Office Action, the Examiner rejected claims 6-10, 14, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Wu in view of Yamamoto. M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) Additionally, one helpful standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Applicant respectfully submits that the references cited by the Examiner, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Applicant also respectfully submits that there is no suggestion or motivation to combine the references in the manner suggested by the Examiner, and that one of skill in the art would not reasonably expect success in combining the references in the manner provided. Therefore, taking into account the relevant *Graham* inquiries, it is clear that the claim set provided herein is not made obvious by the cited references.

Specifically, as discussed in detail above, Wu does not teach the claim limitations included in the independent claims regarding comparing multiple test print jobs from a single

printer driver. Instead, Wu teaches comparing a single test print job sent to multiple printer drivers. (See above discussion, Abstract, Col 1 lines 62-64, Col 2 lines 34-37, Col 10 lines 57-60, for example.)

Yamamoto also fails to teach such limitations. Specifically, Yamamoto teaches a system that provides a hard-copy test print to determine the effect of various image processing parameters on an image. (Abstract) The hard-copy test print of Yamamoto prints off multiple copies of a single portion of an image with different image processing effects (such as density, sharpness, etc.) on one or multiple pages of the hard-copy test print. (Paragraphs 69, 58, 63, for example.) The copy of the image portion having the best image rendering may then be selected for use in a production print. (See end of paragraph 51, for example.) What is clear from Yamamoto is that the selection is made based on a user's visual observation of the hard-copy test print images to select that image having the best rendering for use in making the production print. (See Figs 6A, 6B, and 7 and paragraphs 27 and 70, for example. See also paragraph 72, where it indicates that the user enters in the selected symbols corresponding to the desired print settings.)

In contrast, claim 1 requires: "using the printer model database generation application to perform an analysis process comparing differences between the plurality of test print jobs as output by the first printer driver to generate a printer model database entry for the first printer driver." As the system and method of Yamamoto utilizes a person to perform any comparison and analysis, Yamamoto fails to teach this limitation. Independent claims 12 and 16 contain similar limitations that distinguish over Yamamoto, as discussed above. As neither reference teach these claim limitations alone, the references also fail to teach these limitations in

combination. Therefore, the cited references fail to teach all claim limitations. Such limitations are contained in the rejected claims by dependency.

Applicant also respectfully submits that one of skill in the art would not be motivated to combine Yamamoto and Wu in the manner suggested by the Examiner. The Office Action stated that the references were combinable “because they are from the same field of endeavor, test printing.” (See Office Action at page 9, first full paragraph.) Applicant respectfully disagrees, as the above discussion clearly shows that the systems of Wu and Yamamoto are clearly and strikingly different, and one of skill in the art would not be motivated to combine the references. Specifically, Wu is directed to a system that compares the output of different printer drivers in a digital format without actually providing a hard-copy print. (See portions of the specification relied on by the Examiner discussing the storage of the output, such as a test information output file; Col 10 lines 32-56, for example.) The system of Wu is to detect failures in a new printer driver as compared to the known output from an old printer driver. (Col 1 lines 37-45; Col 1 lines 62-64.)

In contrast, Yamamoto relies on a hard-copy output and a visual inspection by the user so as to select a preferred set of image processing settings. (Fig 6A, 6B, and 7 and paragraphs 27, 70, and 72, for example.) Thus the Yamamoto system and method relies on an incompatible and entirely different mechanism than that shown in Wu system.

In fact, Wu specifically teaches away from the combination of references, as it teaches against making a visual comparison of outputs in the manner disclosed by and used in Yamamoto. A prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness. M.P.E.P. § 2145; *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (emphasis added). In fact, it is improper to

combine references where the references teach away from their combination. M.P.E.P. § 2145; *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Wu teaches that comparing two printed pages is a difficult task, as the pages may contain visually imperceptible differences. (Col 1 lines 48-50) Therefore, Applicant respectfully submits that the proposed combination of references is improper and that one of skill in the art would not combine the cited references in the manner suggested by the Examiner.

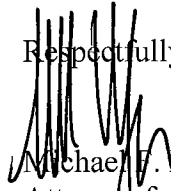
For at least these reasons, Applicant respectfully submits that claims 6-10, 14, and 19 are not made obvious by and are patentable over the cited references. Applicant therefore respectfully requests removal of all rejections under 35 U.S.C. § 103(a).

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 24 day of September, 2007.

Respectfully submitted,


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